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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,338	11/27/2001	Jeffry J. Grainger	020313-000730US	1985
20350	7590	01/21/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			MOONEYHAM, JANICE A	
		ART UNIT	PAPER NUMBER	3629

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/996,338	GRAINGER, JEFFRY J.
	Examiner	Art Unit
	Jan Mooneyham	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 December 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 4-9,11-13,19 and 20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 4-9,11-13,19 and 20 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. This is in response to the applicant's communication filed on December 18, 2003 wherein the applicant request reconsideration of the Final Office Action mailed September 25, 2003. The applicant notes that one of the references cited by the Examiner is a PCT that does not qualify as prior art under 35 U.S.C. 102(e) since it does not designate the United States. The Examiner hereby withdraws the finality of the September 25, 2003 Office Action and reopens prosecution of the application.

Claims 4-9, 11-13, 19 and 20 are currently pending in this application

Response to Amendment

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4-9, 11-13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano et al (US 6,434,580) in view of Serbinis et al. (US 6,584,466).

As for Claim 19:

Takano discloses:

For a plurality of different and unrelated technology developers, allowing client systems from each such technology developer to create a plurality of invention disclosures (invention

reports, draft data for a specification) for each respective technology developer (inventor) ((101), Fig. 4 and related description, col. 7, lines 54-63);

Receiving the plurality of invention disclosures at a server system and storing the plurality of invention disclosures in a database accessible to the server system (plurality of entities for registering plural pieces of invention report information -col. 7, line 54 thru col. 8, line 5);

Storing in the database, additional electronic documents associated with at least some of the plurality of invention disclosures for each technology developer (col. 13, line 45 thru col. 14, line 64);

Maintaining and enforcing rights to the electronic documents in the database such that at least some client systems associated with each technology developer in the plurality of technology developers can assess selected ones of the electronic documents associated with invention disclosures created for the respective technology developer and such that client systems associated with a particular technology developer cannot access electronic documents in the database associated with invention disclosures of other unrelated technology developers in the plurality of technology developers (col. 8, lines 7-24);

Maintaining and enforcing rights to electronic documents in the database for client systems associated with patent firms with the patent firm having rights to view selected invention disclosures stored in the database and create and modify patent applications prepared for selected invention disclosures (col. line 52 thru col. 9, lines 8);

Receiving created patent application at the server system and storing it in the databases (col. 16, lines 26-34);

Maintaining and enforcing rights to file patent applications in a patent office for system associated with a law firm such that only selected client systems have right to file patent applications in the patent office ((patent application filing person);

Electronically receiving a request from a client system to file a particular patent application, determining if the client system has rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office (col. 16, line 15 thru col. 18, line 18, Fig. 18 (1000)).

Takano does not disclose databases for client systems associated with a plurality of patent firms. However, Serbinis discloses a method for Internet-based document management wherein an electronic document may be stored on an Internet-accessible server and accessed using a web browser, downloaded for review or manipulation and returned to the server for access by further users (collaborative file sharing service), col. 2, lines 15-20). The fact that one set of the plurality of users are patent law firms is non-functional descriptive material. This does not effect the document management method that permits users to collaboratively store, retrieve, modify and then return an electronic document to an Internet-based storage site. Therefore, it would have been obvious to one of ordinary skill in the art to have the users be a plurality of law firms since this does not functionally relate to the steps in the method claimed and thus does not patentably distinguish the claimed invention.

As for Claim 20:

Takano discloses:

A processor (inherent in a computer system manipulating data);

A database for storing a plurality of electronic documents (Fig. 1, (300, 310) – the wording “related to a plurality of invention disclosures for a plurality of different and unrelated technology developers, wherein the plurality of electronic documents include invention disclosures, patent applications and additional documents or non-functional descriptive material and thus adds little, if anything, to the claimed structure to serve as a limitation on the claims to distinguish over the prior art).

An invention disclosure component (col. 5, lines 55-61)(101)

A patent creation component (200)

A document management and access component (col. 7, line 51-col. 8, line 24)

A patent application filing component (Fig. 18).

Although Takano discloses that the system is connected to a plurality of inventors, Takano does not disclose that the system is disclosed to a plurality of patent firm users with associated access rights. However, Serbinis discloses a document management system wherein the server is programmed to provide for a plurality of services supported by a common database and document store, including storage and retrieval services (a collaborative file sharing service programmed with a security function) (Fig. 1B, Figs. 2, 3). The fact that one set of the plurality of users are patent law firms is non-functional descriptive material. This does not effect the document management system that permits users to collaboratively store, retrieve, modify and then return an electronic document to an Internet-based storage site. Therefore, it would have been obvious to one of ordinary skill in the art to have the users be a plurality of law firms since this does not functionally relate to the steps in the method claimed and thus does not patentably distinguish the claimed invention.

Referring to Claim 4:

Serbinis discloses an internet based document exchange system (Fig. 1A)

Referring to Claim 5:

The fact that the patent application is filed in the patent office with a correspondence mailing address set to an address associated with the server system instead of an address associated with the first technology developer is non-function descriptive material and is given little patentable weight.

As for Claim 8:

Takano et al. discloses a method and system in which there is a ready template data which make up a specification form for a patent application enabling the inventor to easily prepare a specification for the patent invention (Col. 9, lines 46-51, Fig. 7).

As for Claim 9:

Takano et al. discloses a database for storing patent applications (303) (Fig. 1). Takano does not disclose an access management portion. However, Serbinis discloses one or more access control systems (Security information- Fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an access management portion as taught in Serbinis into the system and method of Takano since patent prosecution is confidential.

As for Claim 11:

Takano discloses the patent application being filed in the patent office electronically in response to a request (Fig. 18)

As for Claim 12:

Eastman does not disclose a method or system in which the patent application is printed on a printer and filed in the patent office by mail. However, this would have been obvious to one having ordinary skill in the art since the filing of patent applications by mail preceded electronic filing.

As for Claim 6, 7 and 13:

Takano discloses receiving from the patent office correspondence related to the patent application being filed (proof transmitting means (502)). Takano does not disclose a system or method in which the paper correspondence from the patent office is scanned into the system and viewed over the Internet. However, it would have been obvious to one of ordinary skill in the art to incorporate scanning into the system and method of Takano because scanning saves time since documents do not have to be entered manually into a system. Viewing the document over the Internet once scanned into the system is also old and well known. It has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192. It would be common sense that the method and system disclosed in Takano would allow for scanned documents and that such scanned documents would be viewed over the Internet.

Response to Arguments

Applicant's arguments with respect to claims 4-9, 11-13, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

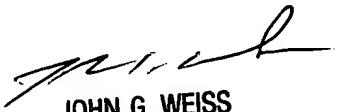
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-308-3691.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

JM



JOHN G. WEISS
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